SUPREME COURT, U.S.
Office Supreme Court, U.S.
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In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 871

KAROLINE CAUER ET AL, HEIRS OF WILHELM ADOLF CAUER, DECEASED,
PETITIONERS,

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS,
RESPONDENT.
(IN THE MATTER OF THE PATENT APPLICATION OF WILHELM ADOLF CAUER, DECEASED)

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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EDWARD J. BRENNER, COMMISSIONER OF PATENTS,
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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners, Karoline Cauer et al, heirs of the late Professor Wilhelm Adolf Cauer, respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled action on June 11, 1964, rehearing denied November 5, 1964.

A certified transcript of the record is furnished herewith, pertinent portions being reproduced in the appendix (App.) hereto for the convenience of the Court.

Opinion Below

The opinion of the Court of Customs and Patent Appeals is reported at 332 F.2d 831 and appears herein in the Appendix, App. A1.

Jurisdiction

The Court of Customs and Patent Appeals rendered its decision in this cause on June 11, 1964 and, following a timely petition for rehearing and reconsideration, denied such petition on November 5, 1964 (App. A6).

The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

Questions Presented

1. Whether the Supreme Court has jurisdiction to review patent decisions of the Court of Customs and Patent Appeals?

2. Whether the Court of Customs and Patent Appeals, under its legislative authority, is powerless to take judicial notice, either of the legislative history of a statute and/or of published acts of the Department of Justice that unequivocally demonstrate an erroneous application of prohibitions of the statute by the Patent Office?

Statutes Involved

The Act of August 6, 1947, P. L. 380, 80th Cong., 1st Sess., 61 Stat. 794, 795 provides in part:

"Sec. 3. Nationals of Germany and Japan may hereafter apply for and obtain patents in the United States for their inventions in accordance with the patent laws and enjoy the rights and privileges thereof: * * *And provided further, That, except for patents based on applications filed in the United States Patent Office prior to the date of enactment of this Act, patents may not be applied for or obtained, or if obtained, shall not be valid, for any *invention made*, or upon which an application was filed by any such national, before January 1, 1946, in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces."

* * * *

28 U.S.C. 1256 provides:

> Court of Customs and Patent Appeals; certiorari.
> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

* * * *

35 U.S.C. 144 provides in part:

> The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. * * *

Statement of the Case

The heirs of the late Professor Wilhelm Adolf Cauer, world-renowned German scientist and father of European electronics, filed a patent application in the United States

Patent Office on May 20, 1963, for Radio-Wave Pulse System.

The Board of Appeals of the Patent Office held that certain claims of the application represented invention over the prior art and, under ordinary circumstances, would be patentable in the Cauer application.

But the Board of Appeals held that no patent could issue because of the prohibition against German nationals of Public Law 380, *supra;* specifically, that, with regard to such nationals,

> "patents may not be applied for or obtained . . . for any *invention made* . . . before January 1, 1946 in Germany . . ." (Emphasis added.)

The Board agreed that if the phrase "invention made" in Public Law 380, Section 3, *supra,* was used with "the usual meaning in patent parlance", then there was "nothing to be prohibited by the Statute", since the Cauer invention was not completed until the 1953 filing date of the patent application.

But the Board ruled that this was a case of first impression and that it believed that it was "the intent of its framers" not to mean "*invention*"; but, rather, any technical information such as mere writings or concepts, whether completed or not.

Since the "conception" was made prior to January 1, 1946 (though under circumstances where Dr. Cauer hid it from the German Government during his persecution by the Nazis), the Board held that the application could not be maintained.

Put into issue, therefore, by the Board, was "the intent of . . . (the) framers" of Public Law 380, Sec. 3.

One of the petitioners' counsel (App. A14) accordingly, investigated the legislative history of Public Law 380,

Sec. 3, in both houses of Congress and in the files of the Commissioner of Patents relating to that statute—*access to which was freely given by the Patent Office.*

Only in the Patent Office file of the legislative history, however, did said counsel discover that, in actual fact, it was the patent experts of the Patent Office itself who were actually the "framers" of the phrase "invention made" —and thus the phrase was, indeed, used in "the usual meaning in patent parlance."

More than this, the Patent Office file of the legislative history showed that Congress specifically declined to amend "invention" to mere "technological information" as requested by the Secretary of Commerce (App. A15).

Your petitioners, accordingly, seasonably appealed to the Court of Customs and Patent Appeals and, in pursuance of the provisions of 35 U.S.C. 143, "specified" that the Commissioner of Patents certify to that Court, as part of the record on appeal, specific documents from the said Patent Office file of the legislative history, that were clear evidence that it was the Patent Office lawyers themselves who were the "framers" of the statutory language and that Congress had insisted on "invention" and not mere technological information and concepts.

Without this evidence so "specified by the appellant" in the appellate record, the Court of Customs and Patent Appeals would have no way of knowing the truth as to the intent of Congress.

The Commissioner of Patents, however, declined to honor your petitioners' request and subsequent petition stating that the Board made no specific reference to the papers in the legislative history file and that the file that had been freely shown to petitioners' counsel, without restriction, had suddenly become "privileged".

The Court of Customs and Patent Appeals summarily denied (App. A7), without reasons or opinion, your peti-

tioners' seasonable motion to compel the Commissioner to perform his ministerial duty.

This Supreme Court denied your petitioners' attempt[1] to compel the Court of Customs and Patent Appeals to perform its duty, 375 U.S. 808.

Your petitioners were thus deprived of an adequate statute-authorized record on appeal.

Holding that because the parts of the legislative history that demonstrated that "invention made" was, indeed, used by Congress in its technical meaning in "patent parlance", and that Congress refused to substitute for "invention" the concept of mere technological information, were

> "not part of the record here", (App. A4)

the Court of Customs and Patent Appeals adopted the Board's speculation that, when Congress said "invention made" it did not mean either "invention" or "invention made", but meant mere technological information including mere writings and concepts.

This apparent view of the Court of Customs and Patent Appeals that it was powerless under its statutory authority (35 U.S.C. 144, *supra*) to take judicial notice of legislative history not printed in the record, is directly contrary to the holdings of this Supreme Court with regard to the *duty*, let alone power, of an Article III court to seek the legislative intent of statutes to be interpreted. (*Tolfree* v. *Wetzler*, 22 F.2d 214):

> It is elementary that the courts judicially notice the reports of executive departments *Tempel* v. *United States*, 248 U.S. 121 (p. 216) . . . The doctrine of

[1] Motion for Leave to File Petition for Extraordinary Writ, and Petition for a Writ of Mandamus or Prohibition, No. 268 Misc., October Term, 1963.

> judicial notice is certainly applicable to all of the Patent Office records. (p. 218)

The Supreme Court has made plain this duty of the courts, whether the documents of legislative history are or are not "part of the record" (*Tempel* v. *United States*, 248 U.S. 121, 130):

> The finding of fact made by the Trial Court (*amplified by the reports of the Secretary of War, of which we take judicial notice*) show . . . (emphasis supplied).

This is the consistent rule of law laid down by the Supreme Court since the days of Chief Justice Marshall (*U. S.* v. *Fisher et al.*, 2 Cranch 358, 386, 2 L. Ed. 304):

> Where the mind labors to discover the design of the legislature, it seizes everything from which aid can be derived . . . (emphasis supplied).

Altogether apart from matters of judicial notice, the Court of Customs and Patent Appeals has declined to follow this Supreme Court's further established rules of statutory construction that, in the absence of a clear record of legislative intent, require the words "invention made" either to be interpreted in their "normal and customary meaning" (*Schwegmann Bros.* v. *Calvert Corp.*, 341 U.S. 384, 388, 1950) or, if they are technical words of art, to be interpreted as the words are used in the patent art and as Congress has previously used the words in the patent and tax statutes.[2]

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[2] Note that the Board of Appeals of the Patent Office has specifically conceded that if "invention made" has "the usual meaning in patent parlance for completion of an invention . . . a conception thereof and a reduction to practice, either actual or constructive", then Dr. Cauer did not make his invention until long after the January 1, 1946 prohibition date of the statute.

Not only did the Court of Customs and Patent Appeals consider itself without statutory authority even to take judicial notice of the legislative history in interpreting the statute, but it declined, also, to take judicial notice of rulings of the Department of Justice that Dr. Cauer, in view of his Jewish ancestry, moreover, was not considered a "German national" by the Nazi regime; whereas Public Law 380 was aimed at German nationals.

These rulings were supplemented by Justice Department published orders returning seized property of Dr. Cauer upon grounds that Dr. Cauer was not such a "German national"[3]—but, again, the Court of Customs and Patent Appeals apparently considered itself powerless to act in the manner of a real Article III court in terms of judicial notice, holding this was

> "not . . . in this record" (App. A5)

Thus the Court of Customs and Patent Appeals apparently considered that it did not have those powers of judicial notice exercised by other Article III courts to do full justice and equity.

Discussion of Question 1

In his brief in opposition to your petitioners' prior motion for a writ of mandamus or prohibition in this cause, the Solicitor General stated

> "Thus, the threshold question is whether the Court [meaning the Supreme Court] has jurisdiction to review patent decisions of the Court of Customs and

[3] Claim No. 59,643, Return Order 4333, January 24, 1963, U. S. Dept. of Justice, returning Dr. Cauer's seized books and other rights vested in the Alien Property Custodian.

Patent Appeals.[4] Recently, the *Glidden Company* v. *Zdanok,* 370 U.S. 530, 578, n. 49, the Court declined to pass on this question."

The jurisdiction of the Supreme Court to hear petitions for certiorari on patent and trademark matters from the Court of Customs and Patent Appeals is thus in great doubt.

Reasons for Granting the Writ

As above stated, the Solicitor General has agreed that this case involves an unsettled and highly vital question as to the Supreme Court's "jurisdiction to review patent decisions of the Court of Customs and Patent Appeals", particularly since that Court "may now be viewed as an Article III court".

Altogether apart from other considerations, it is urged that this Court should hear your petitioners in the present cause to settle, once and for all, this fundamental and far-reaching question, which has been left in doubt by this Court's recent decision in *Glidden Company* v. *Zdanok,* 370 U.S. 530, 578.

It is also vital, in view of the large number of appeals handled by the Court of Customs and Patent Appeals, for this Supreme Court promptly to decide whether, as that Court has now held in the present cause, 35 U.S.C. 144 limits the power of the Court of Customs and Patent Appeals in taking judicial notice of such items as legislative history and published rulings of the Department of Justice, to only that material printed in the record on appeal.

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[4] The Solicitor took the view that Sec. 195, 196 of 36 Stat. 1145, as amended, related to customs cases and "did not refer to patent or trademark cases".

As above indicated, such a limitation on an Article III Court results in rules of statutory construction contrary to the established decisions of the Supreme Court, and in great miscarriages of justice.

Wherefore your petitioners respectfully pray that a writ of certiorari be issued to the Court of Customs and Patent Appeals, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Customs and Patent Appeals be reversed; and that your petitioners be granted such other and further relief in the premises as may be just and proper.

Respectfully submitted,

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No. Ten Post Office Square
Boston 9, Massachusetts
NELSON H. SHAPIRO
640 Washington Building
Washington, D. C.
Attorneys for the Petitioners

Appendix

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
October Term 1963.
Patent Appeal No. 7091.
Serial No. 356,492.

IN THE MATTER OF THE APPLICATION
OF
WILHELM ADOLF CAUER, DECEASED,
BY ADELHEID MARIE CAUER,
HEIR, KAROLINE HELENE CAUER,
HEIR AND GUARDIAN OF MINOR
HEIRS

June 11, 1964

WORLEY, Chief Judge.

The heirs of one Wilhelm Adolf Cauer appeal from the decision of the Board of Appeals which sustained the examiners rejection of claims 1 through 25, the remaining claims in Cauer application Serial No. 356,492, filed May 20, 1953, for Radio-Wave Pulse Systems.

Certain claims were rejected on the prior art, but all were rejected on the ground that appellants are barred from obtaining a patent by the last provision of Section 3 of Public Law 380, 80th Congress, 61 Stat. 794, enacted August 6, 1947. Since it is our view that the board's decision must be affirmed on the latter ground, neither the subject matter nor the rejection on prior art requires discussion.

Public Law 380, in pertinent part, provides:

> SEC. 3. Nationals of Germany and Japan may hereafter apply for and obtain patents in the United States

> for their inventions in accordance with the patent laws and enjoy the rights and privileges thereof: * * * And provided further, That, except for patents based on applications filed in the United States Patent Office prior to the date of enactment of this Act, patents may not be applied for or obtained, or if obtained, shall not be valid, *for any invention made,* or upon which an application was filed by any such national before January 1, 1946, in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces. (Emphasis supplied)

The board briefly, and we think correctly, found the facts to be as follows:

> It appears from the record that while living in Germany W. A. Cauer, the herein named inventor, made certain notes concerning the instant device, but did nothing more in respect to said device, prior to January 1, 1946, the critical date stated in the aforementioned proviso. There is nothing in the record to denote Cauer as anything other than a German national. The notes were carried out of Germany by another, eventually to develop into the present application. Cauer himself was killed prior to January 1, 1946.

In deciding whether Cauer's invention was "made * * *, before January 1, 1946" within the meaning of the statute, the board stated:

> As we see it, the making of an invention is synonymous with the completion of such invention, and the usual meaning in patent parlance for completion of an invention embraces a conception thereof, and a

reduction to practice, either actual or constructive. On such a basis, appellant argues that since there was here no reduction to practice prior to January 1, 1946, there was no invention made prior to this date, and therefore nothing to be prohibited by the Statute.

We are not able to agree that the term in question, as used in the involved proviso of Section 3 of Public Law 380, would have the meaning argued for by apellant, when consideration is given to the purpose of this proviso as evidenced by the intent of its framers.

In the Report of the Committee on the Judiciary of the House of Representatives in connection with Public Law 380 (80th Congress, 1st Session, House Report No. 1060, page 3) the following appears in explanation of said proviso of Section 3:

> In addition, section 3 provides that patents may not be obtained in the United States for inventions made before January 1, 1946. Enactment of such a proviso is considered necessary since it will prevent the patenting here of inventions made by Germans and Japanese during the war, in fact, of all inventions made before January 1, 1946, many of which were brought to this country by operations after hostilities ceased and were made available and given freely to the American public. A similar law has been enacted in Great Britain.

Similar language appears in the corresponding Senate Report (80th Congress, 1st Session, Senate Report No. 728, page 3).

As is well known, upon the cessation of actual hostilities of World War II, much information including mere writings or inventive concepts was collected by official personnel from various repositories in Ger-

> many, for example, and made available to the American public, as through the Office of Technical Services. The above quotation from the House Report would appear to denote as a clear motivation for the proviso of concern the protection of those members of said public acting on such freely given inventive concepts. With this as motivation, it seems clear to us that said proviso was intended to cover mere conception, and thus the notes made by Cauer would fall under the proscriptions thereof. That such notes must have been sufficient to constitute a proper conception would follow if they are to be considered as enough as the basis for the instant application.

Appellants state that the board "admitted that if the words *invention made* are used in the same sense that patent lawyers use them, that [sic] the statute does not bar the present application." They argue that the board erred in holding that the intent of the framers of the act was not to use those words in that sense, and contend instead that "the phrase 'invention made' was actually used with the *usual* meaning in patent parlance by patent lawyer framers."[1] Under such circumstances, appellants contend, "the Board concedes that there is 'nothing to be prohibited by the statute.'"

We do not regard it as significant whether "patent lawyers," who obviously would realize that the term "invention made" might sometimes be used in specific situations in patent practice as indicating a reduction to practice, suggested that term in connection with the consideration of

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[1] In support of the contention that "*patent lawyer* experts of the Patent Office itself" were actually the "framers" of the phrase "invention made," appellants refer to certain documents in a file of the Commissioner of Patents on Public Law 380. Those documents are not part of the record here.

Public Law 380 by Congress. Our only concern is what Congress intended by enacting Section 3 of Public Law 380, i.e., what that Act sought to accomplish. We think the board correctly analyzed the Act as having as an objective the protection of those members of the public who might act on those writings or inventive concepts collected from various repositories in Germany and Japan that were made available after the cessation of actual hostilities of World War II. The term "invention made" cannot be given an interpretation inconsistent with that objective, as the interpretation advanced by appellants would. Rather, it must be construed in the general and less technical sense necessary to include "inventions" of the type made available to the American public as described in the Committe Report quoted by the board[2] without regard to whether they were *reduced to practice* before January 1, 1946.

Appellants additionally suggest that Cauer was not a "German national" because the German Government "declined to consider" him such. However, appellants' oath in the application describes him as "late a citizen of Germany and a resident of Gross-Berlin, Germany." Appellants have not established in this record that Cauer was not a German national, thus we can only regard him as one of those subject to the provisions of Section 3 of Public Law 380.

The decision of the board is *affirmed*.

AFFIRMED

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[2] It is apparent that the Act does not attempt to differentiate between "inventions" on the basis of whether they were actually brought into this country.

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
Washington

George E. Hutchinson
Clerk

November 5, 1964

Mr. Robert H. Rines
Rines and Rines
10 Post Office Square
Room 1318
Boston 8, Mass.

Re: Ex parte Wilhelm Adolf Cauer, deceased, by Adelheid Marie Cauer, Heir and Karoline Helen Cauer, Heir and Guardian of Minor Heirs
Patent Appeal No. 7091

Dear Sir:

This is to advise you that the court has denied petition of appellants for rehearing in the above appeal.

Very truly yours,

(s) GEORGE E. HUTCHINSON
Clerk

m

CC: Mr. Clarence W. Moore
Solicitor, U.S. Patent Office
Washington, D.C.
Mr. Nelson H. Shapiro
801 Washington Building
Washington, D. C. 20005

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS
Washington 25, D.C.

March 15, 1963

Mr. Robert H. Rines
Rines and Rines
10 Post Office Square
Boston 9, Massachusetts

Re: Ex parte Wilhelm Adolf Cauer
Patent Appeal No. 7091

Dear Sir:

This is to advise you that the court denied the motion of appellant to compel the Commissioner of Patents to certify additional material to include in the record in connection with the above-entitled appeal and for a stay of proceedings.

In view of the action taken by the court, the transcript of record will be sent to the printer in due course.

Very truly yours,

/s/ Mary A. Young
Clerk

y

CC: Mr. Nelson H. Shapiro
801 Washington Building
Washington 5, D. C.
Mr. Clarence W. Moore
Solicitor for the Patent Office
Washington 25, D. C.
(Received, Mar. 18, 1963, Rines and Rines, No. Ten Post Office Square, Boston.)

IN THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

In the Matter of
Wilhelm Adolf Cauer, et al
Radio-Wave Pulse System

Appeal No. 7091

Memorandum of Commissioner of Patents in Re Appellant's Motion to Compel the Commissioner to Certify a Complete Record and for a Stay of Proceedings.

* * *

* * * Commissioner's File on Public Law 380 is by no means a public record or file. Such a file normally contains many intra and inter agency communications which have a privileged status. The fact that associate counsel was permitted (erroneously) to inspect that file does not alter the fact that it has a privileged status. * * *

* * *

Respectfully submitted,
/s/ C. W. Moore
Solicitor, U. S. Patent Office.

Joseph Schimmel
Of Counsel.

UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS

In re Cauer } Appeal No. 7091

Motion to Compel the Commissioner of Patents to Certify a Complete Record to This Honorable Court and for a Stay of Proceedings.

Now come your petitioners, in the above-entitled cause, by their attorneys, and move that this Honorable Court issue an order compelling the Commissioner of Patents to perform his ministerial duty of certifying a sufficiently adequate record of the proceedings in the Patent Office to enable this Court to perform its appellate function and your petitioners to present a complete record on appeal.

In view of the apparently novel issue here-involved and in the interest of doing equity and justice in the premises so that your petitioners shall not have to present an appeal based upon an insufficient record, it is further moved that all the proceedings herein be stayed, and that your petitioners be permitted the opportunity of oral argument of this motion.

The grounds for the motion are as follows:

1. In its decision of June 19, 1962, the Board of Appeals held that your petitioners' patent application, here in issue, is "barred by Section 3 of Public Law 380".

2. The pertinent phrase of Section 3 relied upon by the Board was "that patents may not be obtained in the United States for *inventions made* before January 1, 1946".

3. As for the meaning of '*inventions made*", the Board agreed that,

> "As we see it, the making of an *invention* is synonymous with the completion of such invention, and

> the *usual meaning in patent parlance* for completion of an *invention* embraces a conception thereof, and a reduction to practice, either actual or constructive."

4. But the Board held that the term "*inventions made*" was not used in such "patent parlance"; but, "as evidenced by the *intent of its framers*", was "intended to cover mere conception and . . . notes".

5. The Board has thus put in issue the matter as to who were the "framers" and what was their "intent", quoting an extract from the pertinent House Report and referencing the corresponding Senate Report.

6. The Board went further, however, far outside said referenced reports, and quoted supposed "well known" facts concerning "writings or inventive concepts . . . collected by official personnel from various repositories in Germany, for example, and made available to the American public, as through the Office of Technical Services"—another Commerce Department agency.

7. As appears from the accompanying Affidavit of Milton M. Field, your petitioners' counsel investigated the legislative history of Section 3, Public Law 380, to determine who were the "framers", what was their "intent", and how was the "Office of Technical Services" involved—all matters raised by the Board itself, and upon which the Board based its decision herein.

8. The said Affidavit demonstrates that the Patent Office opened to Mr. Field, as a member of the public, without restriction, its file entitled "HR4070, Companion Bill S1707, 80 Cong., 1st Sess., Public Law 380, Commissioner's Files", containing legislative history; and that the documents therein, in Mr. Field's words,

> "clearly show that it was the *Patent Office officials themselves* (including an official who was a member

of the Board of Appeals at the time of the decision in this cause, though not sitting on the panel that rendered such decision) who actually framed the language 'inventions made' of the said Section 3, Public Law 380."

9. It is of the utmost importance and significance for the performance by this Honorable Court of its appellate function, and to do justice, that the truth be made known as to who were the "framers" referred to by the Board; since, as it has turned out, those "framers" were the very *patent* people who use the usual meaning in patent parlance referred to by the Board.

10. It is also necessary for this Honorable Court to know that Congress rejected the Patent Office effort to broaden "inventions made" into "technological information" (Paragraph 6 of Field affidavit)—the broadening now concocted by the Board of Appeals in its decision in this cause.

11. Your petitioners have been unable to find in the House and Senate records the documents and material described in the Field affidavit since that part of the legislative history is apparently contained only in the said Commissioner's Files relating to Public Law 380.

12. In denying your petitioners' request that this part of the legislative history be made available to this Honorable Court (Exhibit II accompanying Field affidavit), and in denying your petitioners' subsequent petition to the Commissioner (a copy of which was annexed to petitioners' Motion for an Extension of Time, granted by this Court on Dec. 12, 1962), the Commissioner is hiding behind newly raised technical grounds, not expressed to Mr. Field when access was freely given, that these documents "are not public documents" and that they are not specifically referenced in the Board's decision.

13. It would be a mocking of justice if the Patent Office were to be permitted to hide behind this shield, particularly when the Board itself definitely put in specific issue the matter as to who were the "framers", what was their "intent", and what part the "Office of Technical Services" played in this matter, and where the facts as to these issues are contained in records controlled by the Patent Office.

14. Legislative historical facts contained in documents controlled by the Patent Office should not be concealed from the Court of Customs and Patent Appeals, particularly since the Board of Appeals obviously had access to the said Commissioner's File on Public Law 380 and, indeed, referred in its decision to so-called "well known facts" and "motivation" that did not come from the said House and Senate Reports and could only have come from the said Commissioner's File and/or the specifically referenced Office of Technical Services.

15. Apart from all other considerations, the Patent Office, as a subordinate tribunal of this Court, having the duty to prepare a complete record for appeal, should not be permitted to suppress facts the absence of which might well defeat the ends of justice by misleading this Court into thinking that non-patent people had suggested the phrase "inventions made".

16. It is believed that your petitioners are entitled to an adequately complete record, and that the Patent Office is not to be held to any less standard of conduct than any other administrative agency that makes a decision based upon evidence peculiarly within the control of that agency, and is under the obligation to provide a complete record to a reviewing court.

17. In the event that this Court considers that its appellate supervisory powers do not permit of the relief herein asked, or some equivalent remedy, then a further

stay is requested to enable your petitioners to seek the ancillary aid of the Federal District Court in compelling the Commissioner to provide the information in his control that has been put in issue by the Board and that is essential to a proper determination of your petitioners' rights.

An oral hearing is respectfully requested.

It is certified that this motion is not interposed for purposes of delay, but is believed to be well founded in fact and law.

A copy of this motion has been mailed this day, first-class postage prepaid, to the Commissioner of Patents, Washington 25, D.C.

Rines and Rines,
By (original signed by Robert H. Rines),
10 Post Office Square,
Boston 9, Massachusetts,
Attorneys for the Petitioners.

Boston, Massachusetts
February 6, 1963
Of Counsel:
Shapiro & Shapiro,
Nelson H. Shapiro,
801 Washington Building,
15th & New York Avenue,
Washington, D.C.

UNITED STATES COURT OF CUSTOMS
AND PATENT APPEALS

In re Cauer } Appeal No. 7091

Affidavit of Milton M. Field.

Washington)
) ss.
District of Columbia)

Being first duly sworn, Milton M. Field deposes and says as follows:

1. My name is Milton M. Field and I am an attorney-at-law associated with the firm of Shapiro and Shapiro, Washington, D.C., associate attorneys of record in the above-entitled cause.

2. In an effort to investigate the legislative history of Section 3, Public Law 380, and to ascertain who were the framers of Section 3 and what their intent may have been in connection with the phraseology of Section 3, I visited the Patent Office on September 26 and 27, 1962, and requested permission to inspect the records of the Patent Office as to the legislative history of Public Law 380.

3. I was supplied, in the Commissioner's Office, with a filed entitled "HR4070, Companion Bill S1707, 80 Cong., 1st Sess., Public Law 380, Commissioner's Files", containing a group of documents that were listed in a subsequent letter to the Commissioner of Patents, dated October 10, 1962, requesting that these documents be reproduced as part of the appeal record in this cause, a copy of which letter is annexed hereto as Exhibit H.

4. I was permitted freely to make notes of all the said documents and no restriction was placed upon any use to which I might put this information, and no one informed

me that any of these documents were not available to the general public.

5. The said documents, on their face, clearly show that it was the *Patent Office officials themselves* (including an official who was a member of the Board of Appeals at the time of the decision in this cause, though not sitting on the panel that rendered such decision) who actually framed the language "inventions made" of the said Section 3, Public Law 380.

6. In the document identified in Exhibit II as the "memorandum from the Secretary of Commerce to the Hon. Earl C. Michener, Chairman of the House Committee", a suggestion was made that the phrase "inventions made" be broadened to include "technological information"; but the latter phrase was not adopted in Section 3, Public Law 380, as enacted.

/s/ Milton M. Field

(Notarized.)

EXHIBIT II

(Received October 17, 1962. Rines and Rines, No. Ten Post Office Square, Boston.)

October 10, 1962

Honorable Commissioner of Patents
Washington 25, D. C.

In re application of
Wilhelm Adolf Cauer (Deceased)
Serial No. 356,492
Filed March 16, 1953
Division 77

Dear Sir:

In the decision of the Board of Appeals in the above-identified application (Appeal No. 247-74, decision dated June 19, 1962) the Board refers on page 5 to the purpose of a proviso of Section 3 of Public Law 380 "as evidenced by the intent of its framers and on page 6 to a clear motivation for the proviso". Because it appears that the Board in reaching its decision had access to the Commissioner's file concerning Public Law 380 (H. R. 4070, 80th Congress, first session), which file was made available to counsel for applicant on September 26 and September 27, 1962, and because it appears that this file contains papers which bear directly on the question of the intent of the framers of Public Law 380, it is respectfully requested that the following additional papers be forwarded to the Document Services Branch to be used in the preparation of the transcript in regard to appeal to the United States Court of Customs and Patent Appeals, and that the cost of the same be changed to the undersigned attorneys:

The entire contents of the Commissioner of Patent's file on Public Law 380, including, specifically, the copy

of the undated memorandum from the Secretary of Commerce to the Hon. Earl C. Michener, Chairman, House Committee on the Judiciary transmitting an attached memorandum of the Commissioner of Patents to the Secretary of Commerce concerning H. R. 4070 with certain additional comments; a memorandum to the Hon. A. S. Fisher from J. C. Green dated July 11, 1947, commenting on H.R. 4070; a State Department memorandum of conference re H.R. 4070 dated July 18, 1947; a State Department memorandum of conference re H.R. 4070 dated July 19, 1947; and any other papers in the file bearing on Section 3 of H.R. 4070, now Public Law 380.

It is requested that these public documents be copied and that certified copies of the same be forwarded to the Court with the papers requested in our letter of September 14, 1962, in accordance with 35 U.S.C. 143.

Very truly yours,

Shapiro and Shapiro
Associate Attorneys for Applicant
By /s/ Nelson H. Shapiro

NHS:mjf

U. S. DEPARTMENT OF COMMERCE

PATENT OFFICE

WASHINGTON

(Copy Mailed December 14, 1962, Commissioner's Office.)

December 14, 1962

In the Application of
Wilhelm Adolf Cauer
Serial No. 356,492
Filed May 20, 1953
For: Radio-Wave
Pulse System

On Petition

Applicant petitions that the action of the Deputy Solicitor refusing to furnish him with certified copies of certain papers in connection with the preparation of the record on appeal to the Court of Customs and Patent Appeals in the above entitled application be set aside. The action complained of was taken on October 17, 1962 and since the instant petition was not filed until December 4, 1962, and no explanation of the delay has been given, the petition might properly be dismissed as late.

The petition has, however, been carefully considered on its merits but no error is found in the action of the Deputy Solicitor which is thought to have been correct for the reasons stated therein. The petition is accordingly denied.

/s/ Edwin L. Reynolds
First Assistant Commissioner

Rines & Rines
10 Post Office Square
Room 1318
Boston 9, Mass.

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON
October 17, 1962
(Copy Mailed October 16, 1962, United States Patent Office Solicitors Office.)

Shapiro and Shapiro
Suite 801
Washington Building
15th and New York Ave. N.W.
Washington 5, D.C.

Dear Mr. Shapiro:

Your letter of October 10, 1962 requesting certification of copies of all papers in the Commissioner's file on Public Law 380, for use in connection with the appeal to the Court of Customs and Patent Appeals in application Serial No. 356,492, in which you appear as associate attorneys, has been referred to this Office.

An examination of the decision of the Board of Appeals in that case shows no reference to or reliance on any paper in that file. The decision refers only to the Report of the Committee on the Judiciary of the House of Representatives (House Report No. 1060, page 3), and to the corresponding Senate Committee Report (Senate Report No. 728, page 3). Apart from the fact that the papers you request are not public documents, and, hence, not generally available to the public, no warrant exists for certifying them to the Court as part of the record of the application or as evidence produced before the Patent Office (35 U.S.C. 144).

Very truly yours,
/s/ J. Schimmel
Deputy Solicitor.

In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 871

KAROLINE CAUER, ET AL., PETITIONERS

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. A1–A5)[1] is reported at 332 F. 2d 831.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on June 11, 1964. A timely petition for rehearing was denied on November 5, 1964. The petition for a writ of certiorari was filed on February 3, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

[1] "Pet. A" refers to the appendix to petitioners' petition; "Pet." refers to the petition; and "R" refers to the transcript of record filed in this Court.

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review, on certiorari, decisions of the Court of Customs and Patent Appeals in patent cases.

2. Whether the Court of Customs and Patent Appeals refused to consider relevant legislative history in construing the statute involved in this case.

STATUTES INVOLVED

The Act of August 6, 1947, P.L. 380, 80th Cong., 1st Sess., 61 Stat. 794, 795, provides in part:

> SEC. 3. Nationals of Germany and Japan may hereafter apply for and obtain patents in the United States for their inventions in accordance with the patent laws and enjoy the rights and privileges thereof: * * * *And provided further,* That, except for patents based on applications filed in the United States Patent Office prior to the date of enactment of this Act, patents may not be applied for or obtained, or if obtained, shall not be valid, for any invention made, or upon which an application was filed by any such national, before January 1, 1946, in Germany or Japan or in the territory of any other of the Axis Powers or in any territory occupied by the Axis forces.

28 U.S.C. 1256 provides:

> *Court of Customs and Patent Appeals; certiorari*
>
> Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari.

* * * * *

35 U.S.C. 144 provides in part:

> The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. * * *

STATEMENT

Petitioners are the heirs of a German inventor, Dr. Wilhelm A. Cauer. On May 20, 1953, they filed an application for a patent based upon certain notes made by Dr. Cauer (R. 3–66). The patent examiner denied their application, holding that it was barred by Section 3 of Public Law 380, 80th Cong., 1st Sess. (R. 81, 84). That section provides, in pertinent part, that nationals of Germany and Japan may apply for patents, but that "patents may not be * * * obtained * * * for any invention made * * * by any such national, before January 1, 1946, in Germany or Japan * * *." On June 19, 1962, the Board of Appeals of the Patent Office affirmed the examiner's decision (R. 93–98). It held that in enacting Section 3, Congress intended to include in the term "invention made" writings or notes from which an invention was developed, such as those prepared by Dr. Cauer (R. 97–98).

Petitioners then appealed to the Court of Customs and Patent Appeals (R. 106). In connection with the preparation of the record on appeal, petitioners requested the Commissioner of Patents to furnish them with a certified copy of a certain Patent Office file on

Public Law 380 (Pet. A16–A17). This request was denied on the grounds that the decision of the Board of Appeals showed no reference to or reliance upon any paper in a Patent Office file; that the papers requested were not public documents; and that no other reason existed for certifying such file as part of the record of the application or as evidence produced before the Patent Office (Pet. A19). Thereafter, petitioners filed a motion with the Court of Customs and Patent Appeals seeking to compel the Commissioner of Patents to certify the file to the court (Pet. A9–A13). The court denied this motion, without opinion, on March 15, 1963 (Pet. A7). Petitioners then sought a writ of mandamus from this Court to compel either the Court of Customs and Patent Appeals or the Commissioner of Patents to submit the Patent Office file as part of the record on their appeal. This Court denied the petition. 375 U.S. 808.

On petitioners' appeal, the Court of Customs and Patent Appeals affirmed the decision of the Patent Office Board of Appeals on the ground that petitioners were "barred from obtaining a patent by the last provision of Section 3 of Public Law 380 * * *" (Pet. A1). The court reasoned that when Congress enacted Section 3 of Public Law 380 it intended to protect those members of the American public "who might act on those writings or inventive concepts collected from various repositories in Germany and Japan that were made available after the cessation of actual hostilities of World War II" (Pet. A5), and said that "[t]he term 'invention made' cannot be

given an interpretation inconsistent with that objective" (Pet. A5). It therefore construed the term "in the general and less technical sense" to include the notes made by Dr. Cauer.

ARGUMENT

1. Petitioners first assert that this Court should grant certiorari in order to settle the question whether it has jurisdiction to review a decision of the Court of Customs and Patent Appeals in a patent case (Pet. 9)—the issue which was left undecided by this Court in *Glidden Company* v. *Zdanok*, 370 U.S. 530, 578, n. 49. Petitioners correctly point out that it has been the government's view—so expressed in numerous briefs in opposition filed since *Glidden*—that the jurisdictional question is important and should be resolved by this Court. We have previously suggested, however, that its resolution should await a case presenting a patent question which is independently worthy of certiorari. Such a question is, in our view, presented by a recent decision of the Court of Customs and Patent Appeals holding that a patent may be obtained on a process for the production of a chemical compound, notwithstanding the applicant's inability to demonstrate any utility for the product, and we have filed a petition for a writ of certiorari in that case. *In the Matter of the Application of Andrew John Manson,* 333 F. 2d 234, No. 932, this Term. No purpose would be served by granting certiorari in the present case, however, since the underlying issue does not warrant review by this Court.

2. Petitioners also contend that in determining the applicability of Public Law 380 the Court of Customs and Patent Appeals erroneously refused to take judicial notice of items not in the printed record such as legislative history and published rulings of the Department of Justice (Pet. 9). In fact, however, the court's opinion makes plain that in construing what Congress meant by the phrase "invention made," the court looked to, and relied upon, several congressional committee reports on Public Law 380 which were not included in the printed record on appeal (Pet. A3–A5). Nor was it error for the court to refuse to consider the Patent Office file on Public Law 380 as legislative history of that statute, since the relevance of that file was highly questionable. Petitioners' contention that it would have demonstrated that the "patent experts of the Patent Office itself" chose the words "invention made" (Pet. 5) could not have significantly affected the result of this case. As the court observed: "We do not regard it as significant whether 'patent lawyers' * * * suggested that term * * *" (Pet. A4–A5). The court properly held that the controlling factor in this case was "what Congress intended by enacting Section 3 of Public Law 380 * * *" (Pet. A5), and not who suggested the statutory language. See *United States* v. *Wise,* 370 U.S. 405, 414; *United States* v. *Bryan,* 339 U.S. 323, 337–338.

3. Petitioners also argue, as they did in the court below (Pet. A5), that Dr. Cauer "was not considered a 'German national' by the Nazi regime; whereas

Public Law 380 was aimed at German nationals" (Pet. 8). Return Order 4333, dated January 24, 1963, on which petitioners rely (Pet. 8, n. 3), establishes no more than that the Alien Property Custodian returned to Dr. Cauer's heirs certain property which had been seized during World War II. The records of the Office of Alien Property reflect that the return order had been based upon Section 32(2)(D) of the Trading With the Enemy Act, 50 U.S.C. App. 32(2)(D), which permits the return of vested property to enemy aliens who suffered religious persecution as a consequence of the laws, decrees or regulations of the country of which he is a citizen. There is thus nothing in this record to indicate that Dr. Cauer was not a "German national" within the meaning of Public Law 380 prior to 1946. Indeed, the record contains a sworn statement by petitioners that Dr. Cauer was, prior to his death, a "citizen of Germany and a resident of Gross-Berlin, Germany" (R. 54).

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ARCHIBALD COX,
Solicitor General.

JOHN W. DOUGLAS,
Assistant Attorney General.

ALAN S. ROSENTHAL,
LAWRENCE R. SCHNEIDER,
Attorneys.

MARCH, 1965.

U.S. GOVERNMENT PRINTING OFFICE : 1965

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In the Supreme Court of the United States

OCTOBER TERM, 1964

No. 871

KAROLINE CAUER ET AL, HEIRS OF WILHELM ADOLF CAUER, DECEASED,
PETITIONERS,

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS,
RESPONDENT.
(IN THE MATTER OF THE PATENT APPLICATION OF WILHELM ADOLF CAUER, DECEASED)

PETITIONERS' REPLY BRIEF

ROBERT H. RINES
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Blanchard Press, Inc., Boston, Mass. — Law Printers

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v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS, RESPONDENT.

(IN THE MATTER OF THE PATENT APPLICATION OF WILHELM ADOLF CAUER, DECEASED)

PETITIONERS' REPLY BRIEF

In his brief for the respondent, the Solicitor General has conceded that petitioners' first question with regard to the jurisdiction of the Supreme Court to review, by certiorari, patent decisions of the Court of Customs and Patent Appeals "is important and should be resolved by this Court" (p. 5).

This same issue, indeed, is stressed in a copending petition in which the Solicitor General has asked this Court to take jurisdiction, *Edward J. Brenner, Commissioner of Patents, Petitioner* v. *Andrew John Manson*, No. 932,

October Term 1964.[1] The same issue is also presented in another petition presently before this Court, *In the Matter Of The Application Of Homer G. Thomson,* Oct. Term, 1964.

But the Solicitor General feels that this Court should not resolve this question in connection with the present petition because the second question presented by that petition, in view of the Solicitor, "does not warrant review by this Court".

As erroneously worded in the second question presented by the Solicitor, your petitioners would agree; but as correctly worded in your petitioners' second question, your petitioners urge that it is also for the Supreme Court to determine whether all Article III courts have powers and duties of judicial notice, or whether the Court of Customs and Patent Appeals—though now an Article III court—is forbidden by 35 U.S.C. 144, *as it has specifically held in the present cause*, even to consider parts of the legislative history of a statute and published rulings of the Department of Justice that were not part of the written "record" in the Patent Office.

As for the merits of the present litigation, if the Court had the duty and the power to consider all of the legislative history, and not just what was in the "record" in the Patent Office, it is not disputed but that, in actual fact, the Secretary of Commerce had been turned down by Congress in an effort to change the phrase "invention made" to the broader "technological information" meaning applied by the Court of Customs and Patent Appeals.

Thus, the statute must be construed as "*invention made*" and not just any "technological information", unless the

---

[1] Note that the Solicitor General now says this Court *has* jurisdiction; whereas some months ago, the Solicitor urged this Court not to hear an extraordinary writ of your petitioners (*Karoline Cauer et al* v. *The Honorable Justices of the United States Court of Customs and Patent Appeals*, No. 268., Oct. Term, 1963), taking just the opposite view that the Supreme Court had *no* such jurisdiction!

Court of Customs and Patent Appeals is correct that 35 U.S.C. 144 forbids it to consider legislative history "not part of the record" in the Patent Office and thus the will of Congress is to be thwarted.

So, also, in what the Court of Customs and Patent Appeals deems its absence of power to take judicial notice of published rulings of government agencies "not part of the record" in the Patent Office, that court held that the patent application oath that Professor Cauer was at one time a "citizen of Germany" meant that he was prohibited from filing a patent application.

In actual fact, the published decisions of the Justice Department recognizing the religious persecution to which Dr. Cauer was subjected—and which the Solicitor General *now admits* in his brief, p. 7—show clearly that Dr. Cauer, under the laws and decrees of Germany did *not* have the full attributes of German Nationality and therefore was not a "German National" within the meaning and intent of PL380.

An article III court would have the power to take notice of these decisions of the Justice Department, which occurred after the proceedings in the Patent Office, but the Court of Customs and Patent Appeals feels it cannot do so under 35 U.S.C. 144.

This question of the jurisdiction of the Court of Customs and Patent Appeals (also raised in said copending *Homer G. Thomson* petition), like petitioners' first question, appears to be an important jurisdictional question promptly to be settled, also, once and for all, so that granting of the petition is earnestly solicited.

Respectfully submitted,

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Boston 9, Massachusetts
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EDWARD J. BRENNER, COMMISSIONER OF PATENTS,
RESPONDENT.
(IN THE MATTER OF THE PATENT APPLICATION OF WILHELM ADOLF CAUER, DECEASED)

PETITION FOR REHEARING

ROBERT H. RINES
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PETITIONERS,

v.

EDWARD J. BRENNER, COMMISSIONER OF PATENTS,
RESPONDENT.

PETITION FOR REHEARING

Since denying the petition herein,[1] this Court has decided after all to decide your petitioners' first question as to the jurisdiction of the Supreme Court to review, by certiorari, patent decisions of the Court of Customs and Patent Appeals, in *Edward J. Brenner, Commissioner of Patents, Petitioner* v. *Andrew J. Manson*, No. 932, October Term, 1964.

This points up the importance of deciding, also, your petitioners' second question as to the limitation upon the

[1] By order dated April 15, 1965, the Chief Justice extended the time for filing this petition for rehearing to and including May 23, 1965.

jurisdiction of the Court of Customs and Patent Appeals itself that such Court has held, in your petitioners' case, is imposed by 35 U.S.C. 144.[3]

Since denying your petitioners' petition, indeed, this Supreme Court has rendered a further decision *requiring* that courts assume the very duty i legislative interpretation brought out by your petitioners' second question, that the Court of Customs and Patent Appeals has here held it cannot do:

> "In order to determine congressional intent, we *must* examine the purposes and policies underlying the . . . Act itself . . ." (including taking judicial notice of published documents, as in footnote 3), *Otto* v. *Burnett, Petitioner* v. *New York Central Railroad Company*, No. 437, October Term 1964, page 4 of Mr. Justice Goldberg's opinion of April 5, 1965.

This is squarely in conflict with the Court of Customs and Patent Appeals refusal to take judicial notice of the legislative history herein because:

> "Those documents are not part of the record here". (A4)

It is believed of great importance to the thousands of patent and customs litigants in the Court of Customs and Patent Appeals to have the Supreme Court pass on whether, unlike the Supreme Court and other Article III Courts, the Court of Customs and Patent Appeals must, under 35 U.S.C. 144, undertake to interpret statutes without reference to portions of the legislative history not "part of the record" in the Patent Office.

---

[3] Petition for Writ of Certiorari, p. 3, 6.

Reconsideration and granting of the petition are thus requested.

Respectfully submitted,

RINES AND RINES

ROBERT H. RINES
DAVID RINES
No. Ten Post Office Square
Boston, Massachusetts
NELSON H. SHAPIRO
640 Washington Building
Washington 5, D. C.
Attorneys for the Petitioners

CERTIFICATE OF COUNSEL

I hereby certify that the foregoing petition for rehearing is presented in good faith and not for delay and is restricted to grounds specified in Rule 58 of the Rules of this Court.

Attorney for the Petitioners